

REMARKS

This is a full and timely response to the non-final Office Action mailed on June 7, 2004 (Paper No. 18). Claims 38, 51, 54-56, 61, and 64-65 are directly amended and claims 66-69 are newly added. Claims 38-69 are pending in the present application. Reconsideration and allowance of the application and present claims are respectfully requested. Applicants should not be presumed to agree with any statements made by the Examiner regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by the Applicants.

I Interview Summary

Applicant first wishes to express his sincere appreciation for the time that Examiner spent with Applicants' Attorneys, Jeff Kuester and Minh Nguyen, during a telephone discussion on August 5, 2004 regarding the outstanding final Office Action. The discussion involved the claim objection, the 112 rejection, Figs. 5 and 6 of the application, claim 38, U.S. Patent No. 5,959,748, and U.S. Patent No. 5,721,829. During that conversation, the Examiner seemed to indicate that it would be potentially beneficial for Applicants to make the amendments to claim 38 to overcome the claim objection and 112 rejection. However, no agreement was reached on the 102 and 103 rejections.

II. Response to Claim Objection and Claim Rejections Under 35 U.S.C. § 112, First Paragraph

In the Office Action, claims 38-50 and 56-60 are rejected under 35 U.S.C. 112, as allegedly being not enabled. The Office Action alleged that a feature of claims 38 and 56 is not enabled in the specification, particularly the feature of providing a list of selectable VOD titles responsive to determining that the active VOD session does not exist. Applicants respectfully submit that the claims have been amended to overcome the objection and rejections. Consequently, Applicants respectfully request that the objection and the rejection of the claims be withdrawn.

III. Response to Claim Rejections Under 35 U.S.C. § 102

Claims 51, 53-55, 61, and 63-65 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,969,748 to *Casement, et al.* Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claims 51 and 53-55

Claim 51, as amended, recites:

51. A method comprising the steps of:
providing a selectable option for renting at least one VOD presentation;
receiving a first user input configured to select the selectable option for renting the at least one VOD presentation;
responsive to receiving the first user input, determining whether the at least one VOD presentation is blocked based upon a defined number of rentals;
responsive to determining that the at least one VOD presentation is blocked based upon the defined number of rentals, prompting a user to provide a second user input identifying a first access code for unblocking the at least one VOD presentation;
receiving the second user input identifying the first access code;
responsive to receiving the second user input identifying the first access code, prompting the user to provide a third user input identifying a second access code; and
providing the user with the at least one VOD presentation responsive to receiving the third user input.

(Emphasis Added)

Applicants respectfully submit that *Casement* fails to disclose or teach at least the feature of “responsive to receiving the first user input, determining whether the at least one VOD presentation is blocked based on a defined number of rental”, as recited in claim 51. In fact, *Casement* apparently discloses as follows:

The present invention is directed to a television schedule system with a user interface that allows a user to control access to television programs by time,

rating, content, and/or channel. Furthermore, the user may set a limit on pay-per-view (PPV) spending to limit the purchase of PPV programs.

Casement apparently does not disclose controlling television programs by the number of rentals. Consequently, Applicants respectfully submit that not every feature of the claimed invention is represented in the *Casement* reference and so *Casement* does not anticipate claim 51. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 51 be allowed and the rejection be withdrawn.

Because independent claim 51 is allowable over the cited art of record, dependent claims 53-55 are allowable as a matter of law for at least the reason that dependent claims 53-55 contain all features and elements of their respective independent based claim. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 53-55 should be withdrawn for at least this reason, among others.

B. Claims 61 and 63-65

Claim 61, as amended, recites: “prompt a user to provide a first user input identifying a first access code based on a defined number of rentals”. As mentioned with reference to claim 51, Applicants respectfully submit that *Casement* does not disclose controlling television programs by the number of rentals. Consequently, Applicants respectfully submit that not every feature of the claimed invention is represented in the *Casement* reference and so *Casement* does not anticipate claim 61. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 61 be allowed and the rejection be withdrawn.

Because independent claim 61 is allowable over the cited art of record, dependent claims 63-65 are allowable as a matter of law for at least the reason that dependent claims 63-65 contain all features and elements of their respective independent based claim. *In re Fine*, supra. Accordingly, the rejection to dependent claims 63-65 should be withdrawn for at least this reason, among others.

IV. Response to Claim Rejections Under 35 U.S.C. §103

In the Office Action, claims 52 and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Casement*. Claims 38-41, 56 and 57 stand rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent No. 5,721,829 to *Dunn, et al.* in

view of U.S. Patent No. 6,628,302 to *White, et al.* See *Office Action*, page 6, para. 12. Claims 42-50 and 58-59 stand rejected under 35 U.S.C. §102(e) as being unpatentable over *Dunn* in view of *White* and further in view of *Casement*. See *Office Action*, page 8, para. 13. However, the rejections to claims 38-41, 56, 57, 42-50, and 58-59 were made under the Section, entitled “Claim Rejections – 35 USC §103,” and so Applicants assume that the rejections to rejections to claims 38-41, 56, 57, 42-50, and 58-59 were under 35 U.S.C. § 103(a). Applicants request a confirmation of Applicants’ assumption.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all steps/elements/features of the claimed invention to one of ordinary skill in the art. See, e.g., *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

A. Claims 52 and 62

Because independent claims 51 and 61 are allowable over the cited art of record, dependent claims 52 and 62 are allowable as a matter of law for at least the reason that dependent claims 52 and 62 contain all features and elements of their respective independent based claims. *In re Fine*, supra. Accordingly, the rejection to dependent claims 52 and 62 should be withdrawn for at least this reason, among others.

B. Claims 38

Claim 38 recites:

38. A method comprising the steps of:
determining if at least one current rental exists;
responsive to determining that at least one current rental does exist,
determining whether an active video-on-demand (VOD) session for a first
VOD presentation exists;
providing a selectable option to view the first VOD presentation
responsive to determining that the active VOD session exists; and
providing a list of selectable VOD titles responsive to determining that at least one current rental does not exist.

(Emphasis Added)

- i. *Dunn* fails to disclose, teach, or suggest “responsive to determining that at least one current rental does exist, determining whether an active video-on-demand (VOD) session for a first VOD presentation exists.”

In fact, *Dunn* discloses the step of determining whether an unfinished program exists. (Step 204 of Fig. 7, Column 7, lines 25-28). Consequently, Applicants respectfully submit that *Dunn* fails to disclose, teach, or suggest “determining whether an active video-on-demand (VOD) session for a first VOD presentation exists” (Emphasis Added), as recited in claim 38 and so *Dunn* does not render claim 38 obvious. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 38 be allowed and the rejection be withdrawn.

- ii. *White* and *Dunn* teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 38.

The Office Action admits that *Dunn* “does not disclose nor explicitly teach away from a modification so as to “provide a selectable option” in conjunction with the viewing the first VOD presentation. In fact, *Dunn* appears to teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 38. *Dunn* discloses on Column 8, lines 12-17 as follows:

“The pause/resume feature is **automatic and requires no activity on the part of the viewer**. The auto-pause aspect is simply invoked when the viewer switches from the VOD channel prematurely before completion of an ordered program, and the auto-resume aspect is conducted when the viewer returns to the VOD channel.”

(Emphasis Added)

In this regard, the Office Action refers to *White* to remedy the failure of *Dunn* to teach or suggest the above-quoted feature of claim 38. The Office Action alleges as follows:

“The commonly assigned *White et al.* reference discloses a scenario for ‘providing a selectable option to view the first VOD presentation’ (Figure 5). This option is provided if playback of the presentation is paused/stopped by the user, but is not displayed if user [] changes channels during the playback (Col 5, Lines 15-58). If the user stops playback of the presentation and changes channels, then upon returning to the video channel the ‘selectable option’ would continue to be displayed, since the channel change occurred during the playback of the on-demand video as opposed to presentation being paused/stopped. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to provide a “selectable option to view the first VOD presentation” [74] as taught by *White et al.* in response to determining that the active VOD session exists for the purpose of providing the user with a flexible and predictable means to control the playback of active video-on-demand presentations.”

Applicants respectfully submit that *White* does not teach or suggest the above-quoted feature of claim 38 as the Office Action alleged. In fact, *White* teaches away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 38. *White* discloses on Col. 5, lines 46-58 as follows:

“A similar sequence occurs if the user changes to another viewer channel during playback of an on-demand video (e.g. changing to MSNBC to check a sports score). The system interrupts delivery of the on-demand video (e.g. in response to an instruction or notification sent by the client), and a record indicating the point of MPEG interruption is stored. If the user returns to the VIDEO viewer channel within a predetermined period (e.g. 24 hours), the system resumes transmission of the video from the point of interruption. **(No user action, e.g. pressing PLAY, is required—no video control panel is presented in this scenario.)**

Again, the resumed transmission may occur over a different transmission channel, but this detail is transparent to the user.”

(Emphasis Added)

Because *Dunn* and *White* teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 38, Applicants respectfully submit that *Dunn* in view of *White* fails to render claim 38 obvious. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 38 be allowed and the rejection be withdrawn.

C. Claims 56

Claim 56 recites:

56. A digital home communication terminal (DHCT) comprising:
memory; and
program code stored in said memory and configured to enable the DHCT to:
determining if at least one current rental exist
**responsive to determining that at least one current rental does exist,
determine whether an active video-on-demand (VOD) session for a first VOD
presentation exists;**

provide a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists; and
provide a list of selectable VOD titles responsive to determining that at least one current rental does not exist.

(Emphasis added)

- i. *Dunn* fails to disclose, teach, or suggest “responsive to determining that at least one current rental does exist, determining whether an active video-on-demand (VOD) session for a first VOD presentation exists,” as recited in claim 56

As mentioned with reference to claim 38, *Dunn* discloses the step of determining whether an unfinished program exists. (Step 204 of Fig. 7, Column 7, lines 25-28). Consequently, Applicants respectfully submit that *Dunn* fails to disclose, teach, or suggest “determining whether an active video-on-demand (VOD) session for a first VOD presentation exists” (Emphasis Added), as recited in claim 56 and so *Dunn* does not render claim 56 obvious. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 56 be allowed and the rejection be withdrawn.

- ii. *White* and *Dunn* teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 56.

As mentioned with reference to claim 38, *Dunn* appears to teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 56. *Dunn* discloses on Column 8, lines 12-17 as follows:

“The pause/resume feature is **automatic and requires no activity on the part of the viewer**. The auto-pause aspect is simply invoked when the viewer switches from the VOD channel prematurely before completion of an ordered program, and the auto-resume aspect is conducted when the viewer returns to the VOD channel.”

In this regard, the Office Action refers to *White* to remedy the failure of *Dunn* to teach or suggest the above-quoted feature of claim 56. In fact, *White* teaches away from the feature and discloses on Col. 5, lines 46-58 as follows:

“A similar sequence occurs if the user changes to another viewer channel during playback of an on-demand video (e.g. changing to MSNBC to check a sports

score). The system interrupts delivery of the on-demand video (e.g. in response to an instruction or notification sent by the client), and a record indicating the point of MPEG interruption is stored. If the user returns to the VIDEO viewer channel within a predetermined period (e.g. 24 hours), the system resumes transmission of the video from the point of interruption. **(No user action, e.g. pressing PLAY, is required--no video control panel is presented in this scenario.)** Again, the resumed transmission may occur over a different transmission channel, but this detail is transparent to the user.”

(Emphasis Added)

Because *Dunn* and *White* teach away from the feature of “providing a selectable option to view the first VOD presentation responsive to determining that the active VOD session exists,” as recited in claim 56, Applicants respectfully submit that *Dunn* in view of *White* fails to render claim 56 obvious. Accordingly, for at least this reason, among others, Applicants respectfully submit that claim 56 be allowed and the rejection be withdrawn.

D. Claims 39-50 and 57-60

Because independent claims 38 and 56 are allowable over the cited art of record, dependent claims 39-50 and 57-60 are allowable as a matter of law for at least the reason that dependent claims 39-50 and 57-60 contain all features and elements of their respective independent based claims. *In re Fine*, supra. Accordingly, the rejection to dependent claims 39-50 and 57-60 should be withdrawn for at least this reason, among others.

V. Newly Added Claims 66-69

Because independent claims 51 and 61 are allowable over the cited art of record, dependent claims 66-69 are allowable as a matter of law for at least the reason that dependent claims 66-69 contain all features and elements of their respective independent based claims. *In re Fine*, supra. Accordingly, the rejection to dependent claims 66-69 should be withdrawn for at least this reason, among others.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 38-69 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**



Jeffrey R Kuester, Reg. No. 34,367
Attorney for Applicant

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Parkway, NW
Atlanta, GA 30339
Ph: (770) 933 - 9500
Fax: (770) 951 - 0933